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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,599	07/25/2003	Charles R. Slater	06530.0008-04	9736
22852	7590	10/13/2005		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER PEFFLEY, MICHAEL F	
			ART UNIT 3739	PAPER NUMBER

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/626,599

Applicant(s)

SLATER, CHARLES R.

Examiner

Michael Peffley

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 40-121 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40-52 and 64-121 is/are allowed.
- 6) ☒ Claim(s) 53-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/25/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Initially, it is noted that prosecution on the instant application had been suspended by the examiner pending the outcome of interference proceedings with parent application US Serial No. 09/177,502. Upon further consideration of the claims in the instant application and those of the copending parent ('502) application, the examiner has determined that there is no need to suspend prosecution. In particular, the claims of the instant application are drawn to a patentably distinct species of scissor blade that includes a non-conductive layer disposed between a conductive layer and a shearing layer with the non-conductive layer extending to a mounting portion of the blade member. This feature is best shown in application figures 8-13. The parent ('502) application claims are directed to a laminate structure as best depicted in figures 5-7. In view of the independent and distinct species claimed in the instant application, prosecution on the merits is now reopened. A complete action on the merits of pending claims 40-121 follows.

### ***Specification***

The disclosure is objected to because of the following informalities: the specification makes reference to an earlier filed application, which reference should be updated to provide the most current status (i.e. US Patent Number) of the reference application. Pages 9 and 12, for example, make reference to the prior application.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 53-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are unclear with the scope of the claim in view of the preamble. Independent claim 52 is directed to "A blade", but dependent claims 53-63 all make reference to "The scissor blade of claim 52". Either claim 52 should be amended to recite "A scissor blade", or the dependent preambles should be amended to recite "The blade of claim 52" to provide consistent scope for the claimed invention.

***Allowable Subject Matter***

Claims 40-52 and 64-121 are allowed.

Claims 53-63 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: the claims recite a novel scissor blade that includes a layered structure having a non-conductive layer interposed between an outer conductive layer and an inner shearing surface, the non-conductive layer extending to a mounting portion of the blade. Several prior art device provide a non-conductive intermediate layer that is located only on the distal portion of the scissor blade and does not extend to a mounting portion of the blade. Examples of such scissor blades are found in US Patent Nos. 5,252,222 (Rydell) and 5,540,685 (Parins et al). It is noted that US Patent No. 5,658,281 (Heard) discloses a non-conductive support member extending to (and beyond) a mounting portion, the

support including a conductive surface provided on the inner and outer surfaces of the jaw member(s) (see Figures 2-4). However, the Heard patent has a filing date nearly a year later than the priority date of the instant application claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

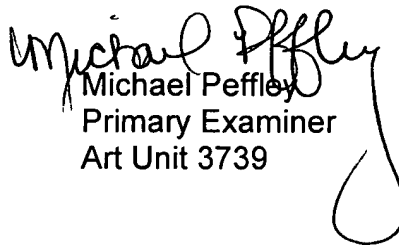
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Eggers (5,324,289) discloses yet another laminate structure scissors blade, and Kortenbach et al (5,569,243) disclose the use of a non-conductive coating on bipolar scissors to prevent shorting.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Peffley  
Primary Examiner  
Art Unit 3739

mp  
October 11, 2005

7. ☒ A check in the amount of \$ 750.00 to cover the filing fee is enclosed.
8. ☒ The Commissioner is hereby authorized to charge any fees which may be required including fees due under 37 C.F.R. § 1.16 and any other fees due under 37 C.F.R. § 1.17, or credit any overpayment during the pendency of this application to Deposit Account No. 06-0916.
9. ☒ Amend the specification by inserting before the first line, the following new paragraph: -- This is a continuation of Application No. 09/177,502, filed October 23, 1998, which is a continuation of Application No. 08/354,992, filed December 13, 1994, abandoned, all of which are incorporated herein by reference.--
10. ☒ New formal drawings are enclosed.
11. ☒ The prior application is assigned of record to: Symbiosis Corporation, Miami, FLORIDA. A copy of the Assignment and Recordation Cover Sheet filed in Application No. 08/354,992 is enclosed.
12. ☐ Priority of Application No. \_\_\_\_\_, filed on \_\_\_\_\_ in \_\_\_\_\_ is claimed under 35 U.S.C. § 119. A certified copy  
☐ is enclosed or ☐ is on file in the prior application.
13. ☐ Small entity status is appropriate and applies to this application.
14. ☒ The power of attorney in the prior application is to at least one of the following: FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P., Douglas B. Henderson, Reg. No. 20,291; Ford F. Farabow, Jr., Reg. No. 20,630; Arthur S. Garrett, Reg. No. 20,338; Donald R. Dunner, Reg. No. 19,073; Brian G. Brunsvold, Reg. No. 22,593; Tipton D. Jennings, IV, Reg. No. 20,645; Jerry D. Voight, Reg. No. 23,020; Laurence R. Hefter, Reg. No. 20,827; Kenneth E. Payne, Reg. No. 23,098; Herbert H. Mintz, Reg. No. 26,691; C. Larry O'Rourke, Reg. No. 26,014; Albert J. Santorelli, Reg. No. 22,610; Michael C. Elmer, Reg. No. 25,857; Richard H. Smith, Reg. No. 20,609; Stephen L. Peterson, Reg. No. 26,325; John M. Romary, Reg. No. 26,331; Bruce C. Zotter, Reg. No. 27,680; Dennis P. O'Reilly, Reg. No. 27,932; Allen M. Sokal, Reg. No. 26,695; Robert D. Bajefsky, Reg. No. 25,387; Richard L. Stroup, Reg. No. 28,478; David W. Hill, Reg. No. 28,220; Thomas L. Irving, Reg. No. 28,619; Charles E. Lipsey, Reg. No. 28,165; Thomas W. Winland, Reg. No. 27,605; Basil J. Lewris, Reg. No. 28,818; Martin I. Fuchs, Reg. No. 28,508; E. Robert Yoches, Reg. No. 30,120; Barry W. Graham, Reg. No. 29,924; Susan Haberman Griffen, Reg. No. 30,907; Richard B. Racine, Reg. No. 30,415; Thomas H. Jenkins, Reg. No. 30,857; Robert E. Converse, Jr., Reg. No. 27,432; Clair X. Mullen, Jr., Reg. No. 20,348; Christopher P. Foley, Reg. No. 31,354; John C. Paul, Reg. No. 30,413;

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